

## REMARKS

This Amendment is responsive to the Office Action mailed July 2, 2009. At the time of the Office Action, claims 1-26 and 40-47 were presented for examination. Claims 1, 18, 21, 23, 25 and 27 are of independent form.

With this Amendment, claims 1, 18, 21, 23, 25 and 47 have been amended. Support for the amended claims is found in the originally filed application, particularly at locations identified hereinafter. Accordingly, no new matter has been added to the application.

Reconsideration and allowance are requested for at least the following reasons.

### **35 U.S.C. § 103 Rejections**

Claims 1-12, 14-26, 40-45, and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker et al., U.S. Patent No. 6,149,620 (“Baker” ) in view of Desai, U.S. Patent No. 5,395,312 (“Desai”).

The Applicant respectfully disagrees with the rejection of claims as being unpatentable over Baker in view of Desai. However, without acquiescing to the properness of the foregoing rejection against the claims, Applicant has elected to amend independent claims 1, 18, 21, 23, 25 and 47 to expedite prosecution and further distinguish from the art. Applicant will now address the cited art in relation to the amended claims.

In the Office Action, Baker is cited for teaching an electrode tip identified as the distal portion of array 504, which may be seen in figure 27A. The Office Action acknowledges that the electrode tip of Baker does not disclose the electrode tip is an electrically conductive cone shaped portion as recited by the claims.

Turning to the secondary reference, Desai is cited for teaching an electrode tip having an electrically conductive cone shaped portion at figure 4G. More particularly, the Office Action recites as follows:

“In this case the recitation of an electrically conductive cone shaped portion, wherein cone shaped portion is broadly interpreted as a portion of a cone and/or cross-section of a cone, for as example a triangle or V shaped object which clearly is met by the electrode shown in figure 4G of Desai.”

To further distinguish from the cited art, Applicant has amended claims 1, 18, 21, 23, 25 and 47 to recite “the portion of the electrode tip extending distally beyond the distal end of the shaft comprising an electrically conductive cone shaped portion, the cone shaped portion having a circular portion which narrows towards the distal end of the device.” Support may be found, for example, in FIGS. 33 and 34 (which are described in the specification at page 40, l. 26 – page 42, l. 6), particularly as shown by the dashed line (to the left of reference character 40 in FIG. 33) around the electrode tip.

Turning to Desai, Applicant believes figure 4G of Desai does not teach the recited cone shaped portion having a circular portion which narrows towards the distal end of the device, particularly as figure 4G is a two dimensional view.

Furthermore, as indicated in a prior response, Desai appears to teach various embodiments for cutting tissue. See, for example, figure 11, which shows, according to Desai, 3 different types of cutting tools. Col. 9, ll. 39-41. Consequently, the Applicant believes that Desai’s devices are intended to cut tissue. Consistent with this understanding of Desai, Applicant believes figure 4G, taken in combination with figures 4E, 4F, 4H and 4I show various cutting tools with differing edges. For example, figure for 4E appears to show a single angled edge; figure 4F appears to show a circular edge; figure 4G appears to show two opposing angled edges or a double edge; figure 4H appears to show a tear drop edge; and figure 4I appears to show a right-angle edge.

Moreover, consistent with cutting tissue, the Applicant further believes the electrostatic probes in figures 4E-4I to actually teach a blade shape. This understanding of Desai appears to better explain why additional views of the operation end 32 were not provided by Desai. In other words, if the electrostatic probes have a blade profile, there would be little reason to show another view for each probe as such may be commonly understood.

Given the foregoing understanding of Desai, the Applicant believes a blade shape electrode would not be expected to have a circular portion which narrows towards the distal end of the device, particularly as the Applicant believes such would inhibit use of the blade for cutting, thus frustrating Desai’s intended purpose.

In addition to the foregoing, with regards to claims 18, 21 and 23, the Applicant does not understand Baker to teach the portion of the electrode tip extending distally beyond the distal end of the shaft comprising a neck portion and an enlarged end portion, the enlarged end portion located distal to the neck portion and comprising an electrically conductive cone shaped portion. In particular, the Applicant does not understand Baker to teach an electrode tip as recited in the claims with a neck portion and an enlarged end portion which is electrically conductive as recited by the claims. Applicant has reviewed figures 27A-27C of Baker as set forth in the Office Action, and does not see any change in the size of electrode terminals 504 along their length. Thus, it is unclear to the Applicant how the Office Action is interpreting Baker to reach the rejection, and the Applicant respectfully requests clarification should the rejection be maintained.

Finally, with regards to independent claim 47, in the Office Action Baker is set forth to teach blunt dissecting the tissue with the distal end of the electrosurgical device at col. 9, line 44 to col. 10, l. 6. Applicant has reviewed the cited passage, and notes that, while Baker appears to teach the application of “high frequency (RF) electrical energy in an electrically conductive fluid environment to remove (i.e., resect, cut or ablate) a tissue structure”, Baker does not appear to teach blunt dissecting the tissue with the cone shaped portion of the electrode tip as recited by claim 47.

The terms “resect” and “ablate” as used in Baker may be understood by the Applicant to mean “removal”, but Applicant does not understand the terms in themselves to specify how such removal is to be performed. With regards to the term “cut”, Applicant believes blunt dissection to relate to the separation of tissue without cutting, which is precisely opposite to cutting and may be distinguished from Baker, as well as Desai.

## **SUMMARY**

The Applicant respectfully submits that, in light of the foregoing amendments and remarks, and having dealt with all the rejections raised by the Examiner, the claims are in order for allowance. A Notice of Allowance is respectfully requested.

If the Examiner desires personal contact for further disposition of this case, the Examiner is invited to call the undersigned Attorney at 603.668.6560.

In the event there are any fees due, please charge them to our Deposit Account No. 50-2121.

Respectfully submitted,

October 2, 2009

By: / Michael J. Gallagher /  
Michael J. Gallagher  
Reg. No. 42,564